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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,472	03/08/2000	NOBORU YANAGISAWA	P4982A	1753

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/521,472

Applicant(s)
Yanagisawa et al

Examiner
Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 29, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) 1-25, 39, 41, and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-38 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Acknowledgments

1. The amendment filed October 29, 2002 (Paper No. 14) is acknowledged.

Election/Restriction

2. Claims 1-25, 39, 41, and 42 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 11.
3. The Examiner again cautions that claims 35-38 as currently claimed are not patentably distinct from claims 26-34. Therefore a restriction between claims 26-34 and 35-38 is still improper. However, if Applicants amend either group of claims so that they are no longer patentably distinct, a restriction between the two groups would likely follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

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5. Claims 26-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanevsky et. al. (U.S. 6,334,109 B1) ("Kanevsky"). Kanevsky discloses the following: receiving advertising information (inherent since how else would it be able to print an advertisement); calculating a billing amount (inherent since advertising is rarely free) based on the advertising information received (again inherent since advertisement costs are based upon size of the ad, duration, black and white v. color, just text or text and images); confirming payment of billing amount (payment of the cost of the ad); storing the information received; the advertising information includes images (inherent in advertisements); receiving check out information (items purchased, etc); retrieving stored advertisement information (the ad size, content, etc); synthesizing the received check-out information with the retrieved advertising information and generating printed data (the receipt with the ad and advertisement); the checkout information includes customer information (stored on the server); selecting and retrieving one advertising information (an ad) from a plurality of advertising information (a plurality of ads); the advertising information includes a period for running an advertisement (inherent since virtually no ad runs forever); the advertising information includes characteristics of an advertisement recipient (the ad information is based in part upon the customer) including gender (column 8, lines 34-37); the ad is printed at whatever size; the billing is based upon duration (inherent in virtually all ads); displaying (in this case printing) an advertisement that is the same size as the printing size of an advertisement (inherent); printing a temporary registration containing an ID (the transaction ID on the receipt); reading the ID; and registering advertisement information in the server (in the advertisement server).

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6. Functional recitation(s) using the word “for” (e.g. “for billing for advertisements printed on receipts” as recited in claim 26) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

7. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 26-38 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky.¹ It is the Examiner's principle position that the claims are anticipated by Kanevsky because the inherency as discussed above. Just because Kanevsky silent as to the billing methods does not mean the billing method are absent from the Kanevsky's embodiment of the invention. To the contrary, since most advertisers must pay for their advertisements, based upon a preponderance of the evidence standard, the missing elements are clearly inherent in the Kanevsky embodiments.

However if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Kanevsky disclosure to include confirming payment after calculating a billing amount, and receiving image information. Such a modification would have implemented the standard business practice of confirming payment before transfer of possession is performed. The alternative would be put the seller in a less advantageous bargaining position if having transferred possession, the receiver is unable to make payment. From a business and bargaining point of view, one of ordinary skill in the art would realize that this is an undesirable position to be in.

10. Finally, claims 26-38 and 40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Dedrick (U.S.

¹ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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5,724,521). It is the Examiner's principle position that the claims are anticipated by Kanevsky because Kanevsky inherently discloses fee processing for a particular customer.

However if not inherent, Dedrick directly teaches billing advertisers based upon the match to the customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kanevsky as taught by Dedrick to include the fee processes. Such a modification would have allowed advertisers to pay for access to individual customers based on how desirable it is for the advertiser to have access to those particular customers.

11. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Schulze et. al. (U.S. 6,233,564 B1) ("Schulze"). Kanevsky discloses as previously discussed but does not directly disclose reading the ID by a terminal. Schulze teaches printing a temporary registration (printing the ID itself) and identifying a person by the card ID reader.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kanevsky as taught by Schulze to include identifying the user with the ID card. Such modification would have provided restricted access to the computer system to prevent fraud, destruction, and other problems. Preventing access is a highly desirable feature in any computer system.

12. Claim 40 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky/Dedrick combination in view of Schulze. The rationale noted above in Paragraph No. 11 applies to this rejection as well..

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13. The Examiner notes that Applicants have declined the Examiner's express invitation² to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings.³ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process, the presumption in favor of the ordinary and accustomed meaning is maintained and is now made final. The claims are therefore interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁴ The Examiner now relies heavily on this interpretation.⁵ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) ("Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning")(Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation concepts apply to all examined claims.

² See the Examiner's previous Office Action, Paper No. 13, Paragraph No. 12 mailed July 25, 2002.

³ The Examiner's request on this matter was reasonable on at least two independent grounds: first, the Examiner's request was simply an express request for clarification of how Applicants intend their claims to be interpreted. Second, the request was reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, June 3, 2002 available at www.uspto.gov/web/offices/com/strat2001/index.htm.

⁴ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁵ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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14. It is the Examiner's position that all claimed features in claims 26-38 and 40 are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

Response to Arguments

15. Applicants' arguments filed October 29, 2002 (Paper No. 14) have been fully considered but they are not persuasive.

16. Applicants amendments have overcome the §101 rejections because Applicants now claim for example "printing" in claim 26.

17. Applicants argue that "most advertisers do not walk up to a kiosk or check-out counter, input their ad, pay for it," The Examiner agrees but advertisers walking up to a kiosk or checkout counter is not claimed. As Judge Clevenger has so eloquently summarized these types of arguments, "The invention disclosed in [Applicant's] written description may be outstanding in its field, but the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

18. Regarding previous paragraph 12, Applicants state "it is not clear as to which term the Examiner is referring to" Paragraph No. 12 from the previous office action, like the Paragraph No. 13 above was provided to Applicants to show the standard by which the Examiner

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interprets the claims (i.e. broadest reasonable interpretation). Therefore the paragraphs apply to all pending claims which are not withdrawn from consideration. The paragraph merely asked if *Applicants desired* to be their own lexicographer. The paragraph simply asks that if *Applicants* answer is yes, then *Applicants* should point out the particular claim at issue and show where it is defined—otherwise “no” will be presumed. In this case, since Applicants’ did not affirmatively answer “yes”, the “no” presumption is maintained and nothing more need be done. Additionally, the paragraphs (paragraph 12 from the previous office action and Paragraph No. 13 above) are intended to estop an applicant from asserting lexicography in subsequent amendments. In other words, if Applicants desires to use lexicography, speak now or forever hold their peace. The Examiner *routinely* deals with applicants who after realizing their invention is not patentable, attempt to invoke lexicography in their 5th or 6th amendment. However, claim meaning is fixed upon filing. *Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000) (holding that Federal Circuit “must determine what the term meant at the time the patentee filed the . . . application.”). We then get into issues of quasi-estoppel as discussed in *In re Baker Hughes Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000), reliance, etc. (Incidentally, in this case, careful review of the paragraphs noted above will show that the Examiner has positioned himself quite well for asserting quasi-estoppel arguments.)

So to prevent this situation in the first place, the Examiner simply asks all applicants up front: “Are you or are you not your own lexicographer?”

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19. Regarding the “confirming payment” argued by Applicants. Confirming payments before proffering goods or services is nothing new. Credit cards routinely confirm payments before transfer of possession (e.g. if paying by credit card, one can not walk out of the store with the allegedly purchased article until payment is confirmed and the user signs the receipt).

20. Regarding Dedrick, the Examiner relies on Dedrick only to show that the advertisement is a function of a particular customer (i.e. the “matching process”) and in turn, the cost of the particular advertisement is “based on the comparison by the matching process.” Nothing more.

Although other aspects of the Dedrick may teach away from the claim invention, the particular features relied upon by the Examiner do not. “A reference is no less anticipatory [or obvious] if, after disclosing the invention, the reference then disparages it.” *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 58 USPQ2d 1508, 1514 (Fed. Cir. 2001) citing *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998).

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Scoggie et. al. (U.S. 5,970,468) which discloses a method of providing shopping aids; Lieberman (U.S. 5,413,341) and Bachman (U.S. 4,87,949).

23. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

24. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and

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enablement, §112 2nd paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. 1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.


25. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their “Remarks” (Paper No 14, beginning on page 5) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied⁶, the Examiner respectfully requests Applicants *in their next properly filed response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have *any* questions regarding the Examiner's positions or have other questions regarding this communication or even previous

⁶ E.g., if the Examiner rejected a claim under §103, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
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January 10, 2003